

REMARKS

Specification

The abstract of the disclosure stands objected to because it does not contain any reference to what is new in this continuation in part application.

The abstract has been amended and is currently in condition for allowance.

Reconsideration and withdrawal of the objection is respectfully requested.

Claim Rejections – 35 U.S.C. §112

Claims 2-6 stand rejected under 35 U.S.C. §112, first paragraph, as being based on a disclosure which is not enabling. Examiner asserts that the term “syndrome” is unclear.

For purposes of clarification and not limitation, Claims 2-6 have been amended and are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 U.S.C. §103

Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jamal (US 5,572,712) in view of Abramovici et al. (US 6,550,030).

For a §103 obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success,

determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1996).

Amended Claim 1 recites a method of accessing the testing means in a Field Programmable Gate Array (“FPGA”) comprised of a plurality of functional groups (“FGs”) comprising “inputting a function netlist defining a user circuit; compiling said function netlist; and generating a logic Built-In Self Test (“BIST”) netlist; wherein said BIST netlist replaces all user registers with scan registers with a scan chain routed as the physical silicon scan chains.”

Neither Jamal nor Abramovici teaches the BIST netlist replacing all user registers with scan registers with a scan chain routed as the physical silicon scan chains, as required by Claim 1 of the present invention.

Since neither Jamal nor Abramovici discloses this claim element, their combination cannot teach them. Therefore, it would not have been obvious to one with ordinary skill in the art to combine Jamal and Abramaovici in order to arrive at the present invention.

Since Claims 2-4 depend from Claim 1, they are also patentable as they include the same limitations as their parent claim.

Therefore, Applicants respectfully submit that Claims 1-4 are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 5-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bhawmik et al. (US 6,463,560) in view of Abramovici et al. (US 6,550,030).

Amended Claims 5-6 both include the claim limitation discussed above, wherein the BIST netlist replaces all user registers with scan registers with a scan chain routed as the physical silicon scan chains.

Neither Bhawmik nor Abramovici teaches the BIST netlist replacing all user registers with scan registers with a scan chain routed as the physical silicon scan chains, as required by Claims 5 and 6 of the present invention.

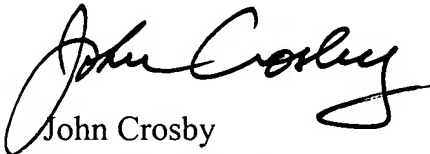
Since neither Bhawmik nor Abramovici discloses this claim element, their combination cannot teach them. Therefore, it would not have been obvious to one with ordinary skill in the art to combine Bhawmik and Abramaovici in order to arrive at the present invention.

Therefore, Applicants respectfully submit that Claims 5-6 are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned at 775-586-9500.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.

Dated: November 29, 2004


John Crosby
Reg. No.: 49,058

Sierra Patent Group, Ltd.
P.O. Box 6149
Stateline, NV 89449
(775) 586-9500 (775) 586-9550 Fax